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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,340	02/25/2004	Hyung-Joon Kim	YOU101	4561

7590 07/23/2007  
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EXAMINER
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ZHU, WEIPING

ART UNIT	PAPER NUMBER
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1742

MAIL DATE	DELIVERY MODE
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07/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/786,340	<b>Applicant(s)</b> KIM ET AL.	
	<b>Examiner</b> Weiping Zhu	<b>Art Unit</b> 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-15 are currently under examination, wherein claims 1, 6 and 12 have been amended in applicant's amendment filed on May 8, 2007.

### ***Status of Previous Rejections***

2. The previous objections to claim 6 for informality is withdrawn in light of applicant's amendments filed on May 8, 2007. The previous rejections to claims 1, 2, 5-8 and 12-15 under 35 U.S.C. 102(b) as being anticipated by WO 99/42638 (relying on the corresponding US patent Kanai et al. US 6,607,587 B1 (Kanai) to establish the rejection ground); the previous rejections of claims 9-11 under 35 U.S.C. 103(a) as being unpatentable over Kanai; the previous rejections of claims 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over Kanai in view of Thompson et al. US 4,684,507 (Thompson); and the previous provisional rejections of claims 1-15 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending application No. 10/786,379 (App '379), corresponding US PGPUB 2005/0186347 A1, in view of Thompson in the Office action of December 8, 2006 are maintained as follows:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 5-8 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanai as stated in the Office action of December 8, 2006.

With respect to the amended features of claims 1 and 12, the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps and those that do not materially affect the basic and novel characteristic(s) of the claimed invention (i.e. improved corrosion resistance). See MPEP 2111.03. In the instant case, some additives still can be included as desired in the resin solution or the mixture of the organosulfur compound solution and the resin solution as disclosed in the instant specification (lines 10-12, page 6). The third ingredient in the surface treatment composition of Kanai's does not materially affect the claimed improved corrosion resistance. Therefore Kanai's teaching still meets the limitations of the amended claims 1 and 12.

With respect to the amended features of claims 6 and 8, they do not change the scope of the claims; therefore, the reasons for the rejections as stated in the Office action of December 8, 2006 are properly applied herein.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanai as stated in the Office action of December 8, 2006.

With respect to the amended feature of claim 9, it does not change the scope of the claim; therefore, the reason for the rejections as stated in the Office action of December 8, 2006 is properly applied herein.

5. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanai in view of Thompson as stated in the Office action of December 8, 2006.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with

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37 CFR 3.73(b).

6. Claims 1-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending application No. 10/786,379 (App '379), corresponding US PGPUB 2005/0186347 A1, in view of Thompson as stated in the Office action of December 8, 2006.

With respect to the amended features of claims 1 and 12, the teaching of App '379 in view of Thompson as stated in the Office action of December 8, 2006 can still be applied properly.

With respect to the amended features of claims 6, 8 and 9, they do not change the scope of the claims; therefore, the reasons for the rejections as stated in the Office action of December 8, 2006 are properly applied herein.

### ***Response to Arguments***

7. The applicant's arguments filed on May 8, 2007 have been fully considered but they are not persuasive.

First, the applicant argues that Kanai requires three-ingredient surface treatment composition, whereas the claimed compositions of the instant invention consist essentially of two ingredients. In response, see the rejections of the amended claims 1 and 12 in the paragraph 3 above.

Second, the applicant argues that Kanai does not disclose a method of using organic solvents to dissolve the thiocarbonyl group-containing compound. In response, the examiner notes that Kanai teaches using alcohols in the coating composition as

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claimed (col. 6, lines 62-67) as stated in the Office action of December 8, 2006. The reason for using the alcohols in the coating of Kanai does not have to be the same as that of the instant invention.

Third, the applicant argues that the Thompson does not teach incorporating the inhibitor into a coating composition and subsequently applying the mixture onto a substrate to provide corrosion protection. In response, the examiner notes that the rejection of said limitations relies on the teaching of Kanai (col. 6, lines 12-33 and col. 7, lines 59-63) not the teaching of Thompson. The motivation to combine Kanai with Thompson as stated in the Office action of December 8, 2007 is proper.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WZ

7/16/2007

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